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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GRANT HOOD and CRAIG PRIEST

Appeal 2007-3410
Application 09/825,412
Technology Center 2100

Decided: March 4, 2008

Before: ALLEN R. MACDONALD, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from a Final
Rejection of claims 1-20.

Claim 1 is exemplary:

1. A method of facilitating exchange of messages at a computerized message exchange system, comprising:

storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;

storing a second plurality of greetings at said server,¹ each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;

allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.²

The Examiner relies upon the following references as evidence in support of the rejections:

Ziskind	2002/0073343 A1	Jun. 13, 2002
Haste, III	6,665,389 B1	Dec. 16, 2003
Lamb	6,747,970 B1	Jun. 8, 2004

Claims 1-14 and 16-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings and suggestions of Ziskind and Haste.³

Claim 15 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings and suggestions of Ziskind, Haste, and Lamb.

¹ We note the lack of antecedent basis for “said server.”

² In our analysis, we refer to this step as the “allowing step.”

³ In our analysis, we refer to the combination of Ziskind and Haste as the “combination.”

We affirm.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Ziskind

1. Ziskind teaches allowing intercommunication between users of different messaging services. (¶¶[0022] and [0031].)
2. Ziskind teaches allowing a first user of a first messaging service the ability to view a directory that includes a second user's status that indicates availability to message, where the second user uses a second messaging service that is different than the first messaging service. (¶¶[0022], [0031], and [0032] (item "listingInUserDirectory").)

Haste

3. Haste teaches a dating service that uses communications methods such as email and telephone to allow people to communicate. (Abstract.)

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

ANALYSIS

Claim 1

The Examiner concludes that the combination renders claim 1 obvious. (Ans. 3-4.) Appellants allege that (a) Ziskind does not teach an introduction service and there is no motivation to modify Ziskind to arrive at an introduction service and (b) the combination does not teach the allowing step. (App. Br. 6-9 and Reply Br. 4-6.) Thus, the issues are whether Appellants have shown that the Examiner erred in the manner set forth in allegations (a) and (b).

Introduction Service

Ziskind teaches allowing interaction between users of different messaging services. (FF 1.) Haste teaches a *dating service* that uses communications methods such as email and telephone to allow people to interact. (FF 3.) “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 127 S. Ct. at 1740 (citing *Sakraida*, 425 U.S. 273, 282). We find that, at the time of the invention, there was sufficient reason to combine the teachings of Ziskind with those of Haste to arrive at an introduction service because combining (a) Ziskind’s communication system with (b) Haste’s dating service that uses communications methods changed the functions of none of the combined features of (a) and (b). Moreover, the combination yielded no more than predictable results of permitting interaction between users of a dating service. *Id.*

Accordingly, we find that Appellants have not shown that the Examiner erred in finding that the combination teaches an introduction service.

Allowing Step

Appellants do not dispute that the combination teaches allowing access to *greetings*, rather Appellants allege that neither Ziskind nor Haste discloses allowing access to greetings to *users of a first service provider* based on two criteria: (1) criteria set by an originator of the greetings and (2) criteria set by the *first service provider*. (App. Br. 7-9 and Reply Br. 4-5.)

Appellants' Specification provides no explicit definition of "criteria" but describes using user preferences to determine whether information is shared and accessed. (Spec. 20:31-21:32.) Accordingly, we broadly but reasonably construe the claimed "criteria" to involve selection or permission.

We find that Ziskind teaches that a first user of a first messaging service is able to communicate with a second user of a second messaging service, where the first and second messaging services are different. (FF 1 and FF 2.) We find that Ziskind's first messaging service as modified by Haste meets the claimed first introduction service provider. Accordingly, we find that the first user of a first messaging service communicating with a user of the second messaging service meets the claimed allowing access to greetings to users of a first service provider.

Next, we address criteria (1). We find that Ziskind teaches that a second user sets a status that indicates an availability to communicate via messaging. (FF 2.) We find that the second user meets the claimed originator and that the second user *selecting* the availability to message meets the claimed allowing access to greetings based on criteria set by an originator of the greetings.

Next, we address criteria (2). We find that Ziskind teaches that when a first user uses a first messaging service, the first messaging service permits access to a directory that indicates which users of a second messaging service are available to message. (FF 1 and 2.) We find that the first messaging service *permitting access* to the directory of user statuses meets

the claimed allowing access to greetings based on criteria set by the *first service provider*.

Thus, we conclude that Appellants have not shown that the Examiner erred in finding that the combination teaches the allowing step. Therefore, we sustain the Examiner's rejections under 35 U.S.C. § 103(a) of claim 1 over the combined teachings and suggestions of Ziskind and Haste.

Other Claims

Claims 1-14 and 16-20 are subject to the same rejection whereas claim 15 is subject to a different rejection. Appellants rely on arguments made with regard to claim 1 for *all* claims on appeal. (App. Br. 7-10.) Therefore, for the same reasons provided *supra* with regard to claim 1, we sustain the Examiner's rejections under 35 U.S.C. § 103(a) of (i) claims 2-14 and 16-20 over the combined teachings and suggestions of Ziskind and Haste and (ii) claim 15 over the combined teachings and suggestions of Ziskind, Haste, and Lamb.

CONCLUSION OF LAW

We conclude that:

(1) Appellants have not shown that the Examiner erred in concluding that claims 1-14 and 16-20 are unpatentable under 35 U.S.C. § 103(a) over the combined teachings and suggestions of Ziskind and Haste;

(2) Appellants have not shown that the Examiner erred in concluding that claim 15 is unpatentable under 35 U.S.C. § 103(a) over the combined teachings and suggestions of Ziskind, Haste, and Lamb; and

(3) Claims 1-20 are unpatentable.

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DECISION

The Examiner's rejection of claims 1-20 is affirmed.
No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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SMART AND BIGGAR
438 UNIVERSITY AVENUE
SUITE 1500 BOX 111
TORONTO ON M5G2K-8 CA CANADA